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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/864,762	05/29/1997	TOKIMORI TOMITA	122.1046-C	7403

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WASHINGTON, DC 20005

EXAMINER

YOUNG, JOHN L

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 01/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
08/864,762

Applicant(s)  
Tomita

Examiner  
John Young

Art Unit  
3622



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Oct 28, 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 78-110 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 78-110 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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REQUEST FOR CONTINUED EXAMINATION (RCE)

AND

REJECTION BASED ON (RCE)

(PAPER 53)

1. The request filed on 10/28/2003 for continued examination (RCE) under 37 CFR 1.114 based on parent Application No. 08/864,762 is acceptable and an (RCE) has been established. An action on RCE follows:

STATUS

2. Claims 1-77 are canceled by Applicant.
3. Claims 78-110 are added (Amendment K).
4. Claims 78-110 are pending.

DRAWINGS

5. This application has been filed with drawings that are considered informal; said drawings are acceptable for examination purposes.

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**CLAIM REJECTIONS - 35 U.S.C. §101**

35 U.S.C. §101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

- 78 78<sup>0</sup>
6. Claims ~~1-80~~, 82-85, 87, 89-91, 93-96 and 98 are rejected under 35 U.S.C. 101, because said claim is directed to non-statutory subject matter.

78 78<sup>0</sup>

As per claims ~~1-80~~, 82-85, 87, 89-91, 93-96 and 98, as drafted said claims are not limited by language to a useful, concrete and tangible application (See *State Street v. Signature financial Group*, 149 F.3d at 1374-75, 47 USPQ 2d at 1602 (Fed Cir. 1998); *AT&T Corp. v. Excel*, 50 USPQ 2d 1447, 1452 (Fed. Cir. 1999) **within the technological arts** (see *In re Waldbaum*, 173 USPQ 430 (CCPA 1972); *In re Musgrave*, 167 USPQ 280 (CCPA 1970) and *In re Johnston*, 183 USPQ 172 (CCPA 1974) also see MPEP 2106 IV 2(b).

Note: it is well settled in the law that “[although] a claim should be interpreted in light of the specification disclosure, it is generally considered improper to read limitations contained in the specification into the claims. See *In re Prater*, 415 F.2d 1393, 162 USPQ 541 (CCPA 1969) and *In re Winkhaus*, 527 F.2d 637, 188 USPQ 129 (CCPA 1975), which discuss the premise that one cannot rely on the specification to impart limitations to the claims that are not recited in the claims.” (See MPEP 2173.05( q )).

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In this case, the claim language lacks explicit recitation of means “within the technological arts.”

**CLAIM REJECTION — 35 U.S.C. §112 ¶4**

The following is a quotation in part of the fourth paragraph of 35 U.S.C. §112 which forms the basis for the following claim rejection set forth in this Office action:

[A] claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation to the subject matter claimed.

7. Dependent claim 99 is rejected pursuant to 35 U.S.C. §112 ¶4 because it fails to contain a reference to a claim previously set forth. . . .”

**CLAIM REJECTIONS — 35 U.S.C. §102**

The following is a quotation of 35 U.S.C. §102 ( b ) which forms the basis of the novelty rejections set forth in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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8. Independent claims 78, 87, 89, 98, 100 & 110 and dependent claims 79-86, 88, 90-99, 101-108 & 110 are rejected under 35 U.S.C. §102 ( b ) as being anticipated by Schultz 5,056,019(10/8/1991) (herein referred to as “Schultz”).

As per independent claims 78, 87, 89, 98, 100 & 110, Schultz (the ABSTRACT; FIG. 1; FIG. 2; col. 1, ll. 6-11; col. 1, ll. 15-16; col. 6, ll. 1-67; col. 5, ll. 1-67; col. 10, ll. 43-53; and whole document) inherently meets the limitations of the claims at issue by showing: *“A marketing method for providing manufacturer purchase reward offers by automatically tracking the purchases of member consumers through the use of barcoded membership cards and using the purchase records in a data processing system to determine if the required purchases have been made to earn a reward. Each member consumer receives a reward booklet disclosing the available reward offers, a periodic status report indicating the member consumer’s progress toward earning rewards, and a reward certificate for those rewards earned. . . . [see the ABSTRACT] The gift offers and sweepstakes offers can also be adapted to provide continuous purchase incentives. The manufacturer can offer to credit the consumer with points for each purchase. . . . A gift is earned when a particular number of points is attained by the consumer. . . . [see col. 6, ll. 5-10; and] the retail store . . . may offer points according to the volume of purchases a consumer . . . makes. . . .”*

Schultz discloses the inventive concept of the claimed invention recited in claim 1. Therefore, the elements of the claims at issue read on the disclosure of Schultz cited above.

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As per dependent claims 79-86, 88, 90-99, 101-108 & 110 Schultz (the ABSTRACT; FIG. 1; FIG. 2; col. 1, ll. 6-11; col. 1, ll. 15-16; col. 6, ll. 1-67; col. 5, ll. 1-67; col. 10, ll. 43-53; and whole document) inherently meets the limitations of the claims at issue by showing: *"A marketing method for providing manufacturer purchase reward offers by automatically tracking the purchases of member consumers through the use of barcoded membership cards and using the purchase records in a data processing system to determine if the required purchases have been made to earn a reward. Each member consumer receives a reward booklet disclosing the available reward offers, a periodic status report indicating the member consumer's progress toward earning rewards, and a reward certificate for those rewards earned. . . . [see the ABSTRACT] The gift offers and sweepstakes offers can also be adapted to provide continuous purchase incentives. The manufacturer can offer to credit the consumer with points for each purchase. . . . A gift is earned when a particular number of points is attained by the consumer. . . . [see col. 6, ll. 5-10; and] the retail store . . . may offer points according to the volume of purchases a consumer . . . makes. . . ."*

Schultz discloses the inventive concept of the claimed invention recited in claim 1. Therefore, the elements of the claims at issue read on the disclosure of Schultz cited above.

## RESPONSE TO ARGUMENTS

9. Applicant's arguments filed 10/28/2003 (Amendment K, paper# 52) have been fully

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considered but they are not persuasive for the following reasons:

Applicant's argument (Amendment K, paper#52) are moot based on new grounds of rejection necessitated by Applicant's amendments.

### CONCLUSION

10. Any response to this action should be mailed to:

Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450

Any response to this action may be sent via facsimile to either:

(703) 746-7239 or (703) 872-9314 (for formal communications EXPEDITED PROCEDURE) or  
(703) 746-7239 (for formal communications marked AFTER-FINAL) or  
(703) 746-7240 (for informal communications marked PROPOSED or DRAFT).

Hand delivered responses may be brought to:

Seventh floor Receptionist  
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2451 Crystal Drive  
Arlington, Virginia.

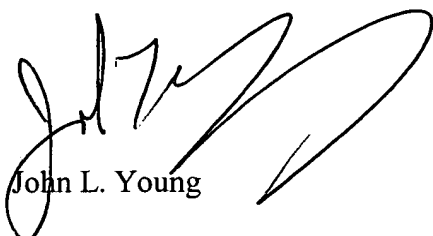
Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Young who may be reached via telephone at (703) 305-3801. The examiner can normally be reached Monday through Friday between 8:30 A.M. and 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, may be reached at (703) 305-8469.



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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

A handwritten signature in black ink, appearing to read 'John L. Young', is written over the printed name.

John L. Young

Primary Patent Examiner

January 9, 2004